

REMARKS

Reconsideration of the subject application is respectfully requested in light of the comments which follow. Claims 1-3, 5, 7-20 and 25-40 are pending.

Claim Rejections Under 35 U.S.C. §103

Claims 1-3, 5, 7-20 and 25-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Martensson* (U.S. Patent No. 6,763,643) in view of *Nelson* (U.S. Patent No. 2,497,837). This rejection is respectfully traversed.

Claim 1 recites, *inter alia*, that the opposing long edges of the floorboard have a length not exceeding 80 cm, and the opposing short edges of the floorboard have a length not exceeding 10 cm.

Claim 1 has now been amended to clarify that the connectors along the short edges of the floorboard are adapted for locking together the floorboard and the third floorboard *only* in a horizontal direction, perpendicular to the vertical plane. As such, the short edge connectors are defined as including a first short edge having a strip extending from the underside of the floorboard and a locking member projecting upwardly from the strip, wherein the strip and the locking member extend beyond the vertical plane; and a second short edge having a groove on the underside arranged parallel to the second short edge, wherein no part of the second short edge extends beyond the vertical plane so as to enable the second short edge to be folded down vertically onto the strip of the first short edge so that the locking member fits into the underside groove to effect horizontal locking.

Claim 1 is thus not only allowable for the reasons clearly set forth earlier in this application, it is also now allowable because of the combination that includes the claimed short edge connectors. A preferred embodiment of the now claimed short

edge connectors is illustrated in Figure 9f. See also the description in paragraph [0086] of the published application US 2004/0139678. Using the now claimed connectors, a herringbone pattern (see Figure 16) can now be easily laid without having to snap in the connectors. However, the claimed invention is not limited to the preferred disclosed embodiments.

The applied prior art does not teach or suggest the claimed combination of claim 1.

Furthermore, the Official Action correctly notes that *Martensson* does not disclose that the opposing long edges of the floorboard have a length not exceeding 80 cm, and the opposing short edges of the floorboard have a length not exceeding 10 cm. The Official Action looks to the teachings of *Nelson* to cure *Martensson's* deficiencies. The Official Action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Martensson* as taught by *Nelson*, such that *Martensson's* floorboard is made of *Nelson's* dimensions as a matter of design choice, in order to fit into particular areas where available space is an important consideration.

Nelson pertains to a floor grating embedded with working surfaces of wear-resistant and slip-preventing material disposed in a manner that the material will always be under the foot of a person walking on the floor surface. The floor is comprised of individual boards, and does not include connectors. *Nelson* discusses using a floorboard having a width of 3 inches (7.62 cm) or more (Column 2, lines 8-9).

As pointed out in the prior response, and, contrary to the position set forth in the Official Action, *Nelson* does not disclose the length of the floorboard to be less

than 80 cm. The Official Action relies on *Nelson's* disclosure in Column 1, lines 49-51, to meet this feature of Claim 1. This passage provides only that the a floorboard is of "considerable surface area" and has a "length greatly exceeding its width, which width usually does not exceed 12 inches". Importantly, the dimension not exceeding 12 inches is in the width direction, or the dimension of the short sides of the floorboard. It does not refer to the length of the board (length of the opposing long edges).

Nelson does state that the board has a length "**greatly** exceeding" its width. Thus, a floorboard of a *greater* length is clearly suggested. As such, this disclosure actually teaches away from providing a floorboard having a **shorter** than standard length, as provided in Claim 1.

In the response to Arguments section of the Office Action, the Examiner alleges that "Greatly exceeding may be construed, at most probably, as two or three times the width." However, the Examiner has provided absolutely no support or evidence for this "conclusion". In fact, the figures of *Nelson* contradict such a conclusion. The figures of *Nelson* illustrate floor gratings having a length that is considerably more than two or three times the width of the gratings.

Accordingly, Applicant continues to submit that the prior art cited by the Examiner, either alone or in combination, does not teach or suggest the floorboard of claim 1. Among other things, there is absolutely no teaching of a floorboard having a long edge length not exceeding 80 cm and a short edge length not exceeding 10 cm.

The Official Action again rationalizes combining the teachings of *Nelson* with *Martensson*, "in order to fit [the board] into particular areas where available space is an important consideration". To sustain a rejection on obviousness, there must be

some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness. *KSR International Co. v. Teleflex Inc.* The reasoning provided in the Official Action does not meet this standard.

In the industry, whole floorboards are typically cut down to size by the installer to fit in areas where the whole board would not fit, for example, near a wall surface. This is a result of the floor area not being of a dimension that is an exact multiple of the dimension of the floorboard. This conventional process is explained in U.S. Patent No. 6,863,768 to *Haffner et al* at Column 12, lines 58-64. Even if a floorboard is made of smaller dimensions, some degree of cutting will likely still be necessary to ensure a proper fit and complete coverage of floor area, unless the floor area is of certain dimensions that are exact multiples of the dimensions of the floorboards. Thus, in order to fit floorboards in areas where available space is a consideration, normally sized floorboards are traditionally cut to size. Similarly, smaller floorboards would need the same treatment where they are not dimensioned to be exact multiples of the floor area. Accordingly, one of ordinary skill in the art would not manufacture a new type of smaller floorboard, but rather cut existing standard floorboards to fit in an area where available space is a consideration. Thus, the known teachings in the industry are contrary to the Examiner's asserted reasoning for combining the references.

Applicant also submits that the claimed dimensions of the floorboard offer an unexpected result that would not have been predictable to a person of ordinary skill in the art. Even if the *Nelson* patent taught the claimed dimensions, the mere fact that references can be combined or modified does not render the resultant

combination obvious unless the results would have been predictable to one of ordinary skill in the art. MPEP 2143.01, Part III.

As evidenced by declarations previously made of record in this application, the claimed floorboards provide numerous advantages that were neither expected nor predictable. The declaration by Mr. Gerhard Schultze confirms that floorboards of the claimed dimensions were not previously used in the industry because of the perception that they would lead to higher production costs and material waste. In addition, smaller floorboards were perceived to take more time to install. In Mr. Svante Bernow's declaration it is demonstrated the claimed smaller floorboards can actually be installed in a shorter amount of time than the larger, standard size floorboards. As discussed in the instant specification beginning at line 21 of page 10, the smaller size lends to easier handling of the floorboards, reduced frictional surfaces along the sides of the joint portions, greater flexibility in the boards during installation which permits a lower force to be applied to snap-in the short sides of the boards. As supported by the above the declarations, these results were neither expected nor predicted, as the industry favored the larger floorboards.

Claims 15 and 26 recite features similar to those of Claim 1, including the dimensions of the floorboard. The arguments above regarding Claim 1 are incorporated by reference here, and apply to Claims 15 and 26 as well. Accordingly, withdrawal of the rejection of Claims 1, 15 and 26 is respectfully requested.

As set forth in the prior response, it is unclear if the rejections of Claims 25, 27 and 29 as set forth in the Official Action are made under 35 U.S.C. §103 or §102. While the claims are described as being rejected under §103, it appears an

anticipatory approach has been taken, as there is no mention of obviousness in the rejection of these claims.

Claim 25 pertains to method making a floor of mechanically locked rectangular laminated floorboards. The claim recites numerous method steps, including placing a second floorboard in a second row at an angle to a first floorboard in a first row with an upper joint edge of the second floorboard contacting with a joint edge of the first floorboard, locking a new floorboard in the second row to the short side of the second floorboard, and laterally displacing both the new and second floorboard parallel with respect to the long side of the first floorboard. The second floorboard and new floorboard are then angled down. A non-limiting example is illustrated in Figures 6a-6d and described beginning at line 8 of page 22 in the present application.

The Official Action takes the position that the floor of *Martensson* is "capable of" of being made by the claimed method. By asserting that the floor in *Martensson* need only be "capable of" of being made by the claimed method steps, the Official Action appears to treat the method steps merely as functional limitations in an article claim. This approach is improper, as Claim 25 is a method claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *Martensson* only briefly mentions any steps to follow for making the floor, noting that the joining profile 10 has lips 4 that engage in grooves 11 of the floorboards (column 7, lines 13-15), and that some portions may be "snap joinable" (column 9, line 4). There is no discussion of the in *Martensson* of the method steps

recited in Claim 25, specifically, the locking of the second floorboard and new floorboard together at a short side, laterally displacing both boards parallel with respect to a long side of a the first floorboard, and angling the second and new floorboards down after the lateral displacement, nor are these steps inherent in *Martensson's* disclosure.

Claim 27 pertains to a method of installing a flooring comprising first and second types of rectangular floorboards having integrated connectors. The first and second types of floorboards are mirror-inverted with regard to connectors. In the *Response to Arguments* section, the Examiner states that *Martensson* discloses "mirror images". However, mirror images are not the same as mirror inverted boards.

Martensson discloses a floor made from a number of identical floorboards 1 (see Figure 6) that are joined by separate joining profiles 10. Each floorboard 1 has identical connecting elements, shown partly as a groove 4 along four sides of the bottom of a floorboard (Figure 1) and as separate joining profiles 10. Thus, *Martensson* does not disclose a method of installing a floor using first and second types of floorboards.

Additionally, *Martensson's* floorboards are not mirror-inverted with regard to the connectors. As shown in Figures 1 and 6 of *Martensson*, the floorboards and connectors are identical. For the floor to be properly assembled, the joint profile 10 must be located on the same edge of all of the floorboards, when the joint profile is integrated with a single floorboard. This is further shown in Figures 6 and 8 where both long sides of each floorboard 1 has the same connector 4 and connection arrangement with joining profile 10. Similarly, each floorboard has identically

arranged elements 21 and 22 along the edges of each respective floorboard. *Nelson* does not cure these deficiencies.

The Official Action makes reference to a "mirrored connector 10", however, it is not addressed how this equates to a first and second type of floorboards being mirror-inverted relative to each other with regard to the connector. This reference only addresses the connector itself, whereas the claim recites the first and second type of floorboards are mirror-inverted. Because neither *Martensson* nor *Nelson* disclose a method of installing a floor comprising first and second types of floorboards connectors arranged in a mirror-inverted manner relative to each other, withdrawal of this rejection is respectfully requested.

Further regarding Claim 27, the Official Action alleges that *Martensson* discloses the floorboards as being connected long side to short side, and short side to short side. The Official Action points to Figure 6 of *Martensson* and the "T shaped intersection of corners". Applicant respectfully disagrees with this interpretation.

Claim 27 recites that the first and second types of floorboards are joinable to each other "long side against short side". In *Martensson*, only a long side of one floorboard is "against" the long side of another floorboard. While the short side may be near a long side, it can not be reasonably interpreted as being "against" the long side. It is not seen how in an arrangement where two parallel long sides are in contact against each other, a perpendicularly arranged short side can also be arranged "against" the long side of the other board.

The Official Action indicates that Claim 29 is rejected for the same as reasons as presented in the rejection of Claim 1, and further notes that the floorboards of *Martensson* are capable of being joined in manner set forth in the claim. However,

the Official Action does not address the feature of the claim that the floor includes first and second types of floorboards, and the first type is mirror-inverted relative to the second type with regard to the connectors. As noted above, *Martensson* discloses only a single type of floorboard to be used in the assembly of a floor and does not show the mirror-inverted configuration as claimed.

Similarly, the rejection of Claim 32 is still unclear, where an obviousness rejection is presented under §103, but the rejection is based on elements not recited in the claim. Applicant respectfully requests the Examiner to clarify the record. The rejection refers to *Martensson* as disclosing various elements of a floorboard, then relies on *Nelson* for a teaching of specific dimensions of the floorboard. However, Claim 32 does not recite specific dimensions of the floorboard.

Additionally, features recited in Claim 32 are not addressed in this rejection. Specifically, Claim 32 recites, *inter alia*, a flooring system comprising first, second, third, and fourth types of floorboards, where the long edges of the floor boards have a length that is an even multiple of the length of the short edges, a multiple of the first and second types of floorboards is smaller than a multiple of the third and fourth types of floorboards, and the first and third types of floorboards, as compared with the second and fourth types of floorboards, respectively, are mirror-inverted with regard to the connectors. Claim 32 continues to recite that all of the first, second, third and fourth types of floorboards are joinable with each other long side against short side, short side against short side and long side against long side.

Martensson does not disclose any of the above features. As noted above, all of the floorboards in *Martensson* are identical, and of uniform length (Figure 6). Thus, only one type of floorboard is disclosed. The Official Action refers to the

floorboards being capable of connecting in a horizontal and vertical direction with "mirror board edge image (fig 2c)". It is not clear if this sentence is intended to identify "mirror-inverted" relationship presented in the claim. As discussed above, the claimed mirror-inverted arrangement is not shown by *Martensson* either. Lastly, *Martensson* shows only long side against long side connections and short side against short side connections, but does not show, discuss, or even consider a short side against long side connection. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 2, 3, 5, 7, 9-14, 16-19, 28, 30, 31, 33-40 ultimately depend from one of the independent Claims 1, 15, 25, 27, 29 or 32, which are allowable as discussed above. For at least this reason, these claims are also allowable.


Conclusion

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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